

REMARKS:

Claims 4, 8, and 16 have previously been cancelled.

Claims 1-3, 5-7, 9-15, and 17-35 remain in the application for consideration of the Examiner. Claims 1-3, 5-7, 9-15, and 17-35 stand rejected under 35 U.S.C. § 102(b) over Bowman-Amuah (U.S. Patent No. 6,636,242)

Reconsideration and withdrawal of the outstanding rejections is respectfully requested in light of the following remarks.

REJECTIONS UNDER 35 U.S.C. § 102:

Claims 1-3, 5-7, 9-15, and 17-35 stand rejected under 35 U.S.C. § 102(b) over Bowman-Amuah (U.S. Patent No. 6,636,242).

However, Bowman-Amuah fails to disclose all of the limitations of claims 1-3, 5-7, 9-15, and 17-35, as discussed below. Therefore, Bowman-Amuah cannot anticipate claims 1-3, 5-7, 9-15, and 17-35.

A claim is anticipated by a prior art reference only if the reference discloses or inherently describes every detail of the claim. According to the MPEP, "[a] claim is anticipated only if *each and every element* as set forth in the claim is found, either expressly or inherently described, in a single prior art reference."¹ Also according to the MPEP, "[T]he identical invention must be shown in as *complete detail* as is contained in the ... claim."²

Claims 1-3, 5-7, 9, 10, and 19-25

As previously pointed out in response to the Office Action dated 19 April 2005, Bowman-Amuah fails to disclose or suggest at least the following limitations as recited in claim 1:

¹ MPEP 2131, citing *Verdegaal Bros. v. Union Oil Co. of California*, 814 F.2d 628, 631, 2 USPQ2d 1051, 1053 (Fed. Cir. 1987), emphasis added.

- (a) Generating a work item representing the job to be performed, the work item comprising a change history;
- (b) Placing said work item into a queue based at least in part on the category of the work item;
- (c) Each queue of the plurality of queues in which a work item can be placed is for storing work items representing jobs to be performed;
- (d) Updating the change history of the work item; and
- (e) Placing the work item into one of a plurality of queues based at least in part on one or more tasks to be executed on the work item.

Each of these points is discussed further below.

Point (a)

In the present Office Action, under a section heading "Response to Arguments," the following is stated with respect to point (a):

As per point a) Bowman-Amuah teaches generating a work item representing the job to be performed, the work item comprising a change history (col. 61 line 40- col. 62 line 45; col. 101 lines 49-65; col. 109 lines 45-60; col. 110 line 57-col. 111 line 45). Each print job is sent to a queue based on the type of work and if the printer is available.³

However, Applicants respectfully submit that since the above statement is substantially identical to the original statement of the rejection, it provides no clarification as to how Bowman-Amuah is considered to disclose or suggest the claimed work item comprising a change history. Applicants have reviewed the portions of Bowman-Amuah that are cited, but have found no disclosure or teaching as alleged in the Office Action that is adequate for anticipating this limitation of claim 1. Also, the comment that "[e]ach print job is sent to a queue based on the type of work and if the printer is available" does clearly relate to the claimed work item, particularly in that the claimed work item comprises a change history. Thus, Applicants maintain that Bowman-Amuah fails to teach or suggest generating a

² MPEP 2131, citing *Richardson v. Suzuki Motor Co.*, 868 F.2d 1226, 1236, 9 USPQ2d 1913, 1920 (Fed. Cir. 1989), emphasis added.

³ Office Action, p. 8.

work item, comprising a change history, representing a job to be performed. If the present rejection is maintained, it is respectfully requested that a clear explanation be provided as to how Bowman-Amuah is considered to disclose or suggest this limitation.

Point (b)

In the present Office Action, under a section heading "Response to Arguments," the following is stated with respect to point (b):

As per point b) Bowman-Amuah again teaches the (sic) each print job is place (sic) in a queue for printing (col. 61 line 40- col. 62 line 45; col. 101 lines 49-65; col. 109 lines 45-60; col. 110 line 57-col. 111 line 45).⁴

However, Applicants respectfully submit that the above statement provides no clarification as to how Bowman-Amuah is considered to disclose or suggest the claimed placing of a work item into a queue based at least in part on the category of the work item. The above also fails to acknowledge or address Applicants' previous arguments:

While Bowman-Amuah does disclose the use of queues for such things as print jobs and messages between applications, such disclosure falls short of anticipating the placing of a work item into a queue based at least in part on the category of the work item. Further, the Office Action appears to be equating the table discussed at col. 110, line 57-col. 111, line 45 to the presently claimed work item (applicants, however, do not concede that the table equates to the claimed work item), and there is no disclosure in Bowman-Amuah that the tables are queued, or that the tables are queued into a queue based at least in part on the category of the table.⁵

Also, Applicants have reviewed the portions of Bowman-Amuah that are cited, but have found no disclosure or teaching as alleged in the Office Action that is adequate for anticipating this limitation of claim 1. Further, the comment that "[e]ach print job is place (sic) in a queue for printing" does clearly relate to the claimed placing of a work item, particularly in that the work item is placed based at least in part on the category of the work item. Thus, Applicants maintain that Bowman-Amuah fails to disclose or suggest placing a work item into a queue based at least in part on the category of the work item. If

⁴ *Id.* at p. 9.

⁵ Amendment filed 30 June 2005, p. 11.

the present rejection is maintained, it is respectfully requested that a clear explanation be provided as to how Bowman-Amuah is considered to disclose or suggest this limitation.

Point (c)

In the present Office Action, under a section heading "Response to Arguments," the following is stated with respect to point (c):

As per point c) Bowman-Amuah teaches use of each queue for storing work items representing jobs to be preformed (sic) (col. 101 lines 49-65; col. 109 lines 45-60; col. 110 line 57-col. 111 line 45; col. 70 lines 4-17; col. 61 line 40- col. 62 line 45).⁶

However, Applicants respectfully submit that since Bowman-Amuah does not disclose the queuing of work items based at least in part on the category of the work item, it necessarily follows that Bowman-Amuah also fails to disclose or suggest a plurality of queues in which work items can be placed in this manner.

Point (d)

In the present Office Action, under a section heading "Response to Arguments," the following is stated with respect to point (d):

As per point d) Bowman-Amuah teaches the use of updating the history (fig 191, element 19106; col. 101 line 50- col. 102 line 40; col. 117 lines 53-60; col. 61 line 40- col. 62 line 45); "Print services can also provide the client with information including print jobs status". (sic)⁷

In response, it is first noted that Applicants have reviewed the cited portions of Bowman-Amuah, but have found no disclosure or teaching as alleged in the Office Action that is adequate for anticipating this limitation of claim 1. Second, with respect to the comment that "[p]rint services can also provide the client with information including print jobs status," it is respectfully pointed out that the claimed "change history" is readily distinguished from a "jobs status." A status, such as a "jobs status" is something that is indicative of a present condition. If one wanted to know the present condition of a print job, for example, one

⁶ Office Action, p. 9.

would look to the “jobs status” to find out the current condition, or *status*. For instance, the status may show the print job to be “in process” or “complete.”⁸ On the other hand, a history, such as a “change history,” is indicative of things that occurred in the past. Such information cannot be discerned from a status; the status only informs of the present condition. If one wanted to know what transpired prior to the present condition, or status, one would need to look at a history. Thus, it is respectfully submitted that the disclosure of a status is different from the claimed change history, and as such it is inadequate for anticipating the claimed change history of a work item.

Point (e)

In the present Office Action, under a section heading “Response to Arguments,” the following is stated with respect to point (e):

As per point e) each item of work is placed in a queue based at least in part on one or more tasks (col. 101 lines 49-65; col. 109 lines 45-60; col. 110 line 57-col. 111 line 45; col. 70 lines 4-17; col. 61 line 40- col. 62 line 45).⁹

However, Applicants respectfully submit that, to the extent that the above statement is substantially identical to the original statement of the rejection, it provides no clarification as to how Bowman-Amuah is considered to disclose or suggest placing a work item into one of a plurality of queues based at least in part on one or more tasks to be executed on the work item. To the extent that the above adds reference to columns 70 and 109-111, it remains unclear as to how Bowman-Amuah is considered to disclose or suggest placing a work item into one of a plurality of queues based at least in part on one or more tasks to be executed on the work item. Applicants have reviewed the portions of Bowman-Amuah that are cited, but have found no disclosure or teaching as alleged in the Office Action that is adequate for anticipating this limitation of claim 1. Thus, Applicants maintain that Bowman-Amuah fails to teach or suggest placing a work item into one of a plurality of queues based at least in part on one or more tasks to be executed on the work item. If the

⁷ *Id.*

⁸ Bowman-Amuah, col. 111, line 31.

⁹ Office Action, p. 9.

present rejection is maintained, it is respectfully requested that a clear explanation be provided as to how Bowman-Amuah is considered to disclose or suggest this limitation.

Claims 11-15, 17, 18, and 26-35

With respect to claim 11, this claim recites limitations similar to at least some of those discussed above in connection with claim 1. Therefore, the discussion above in connection with claim 1 applies equally to claim 11, as well as claims 12-15, 17, 18, and 26-35, which depend from claim 11.

Based on the standards set forth in the MPEP and cited above, the disclosure of Bowman-Amuah is *not* sufficient for establishing that Bowman-Amuah anticipates claim 1 because Bowman-Amuah clearly fails to disclose all of the limitations of claim 1 in as *complete detail* as is contained in claim 1. Therefore, it is respectfully submitted that Bowman-Amuah cannot anticipate claim 1, or claims 2, 3, 5-7, 9, 10, and 19-25, which depend from claim 1.

For the reasons set forth herein, the Applicants submit that claims 1-3, 5-7, 9-15, and 17-35 are not anticipated by Bowman-Amuah. The Applicant further submits that claims 1-3, 5-7, 9-15, and 17-35 are in condition for allowance. Therefore, the Applicant respectfully requests that the rejection of claims 1-3, 5-7, 9-15, and 17-35 be reconsidered and that claims 1-3, 5-7, 9-15, and 17-35 be allowed.

LEGAL STANDARD FOR ANTICIPATION REJECTIONS UNDER 35 U.S.C. § 102:

The following sets forth the legal standards for "anticipation."

The events that can lead to anticipation can be divided into the following seven categories, all defined by statute:

1. **Prior Knowledge:** The invention was publicly known in the United States before the patentee invented it.

2. Prior Use: The invention was publicly used in the United States either (i) before the patentee invented it; or (ii) more than one year before he filed his patent application.

3. Prior Publication: The invention was described in a printed publication anywhere in the world either (i) before the patentee invented it; or (ii) more than one year before he filed his patent application.

4. Prior Patent: The invention was patented in another patent anywhere in the world either (i) before the patentee invented it; or (ii) more than one year before he filed his application.

5. On Sale: The invention was on sale in the United States more than one year before the patentee filed his application.

6. Prior Invention: The invention was invented by another person in the United States before the patentee invented it, and that other person did not abandon, suppress or conceal the invention.

7. Prior U.S. Patent: The invention was described in a patent granted on a patent application filed in the United States before the patentee made the invention.

Each of those seven events has its own particular requirements, but they all have the following requirements in common:

1. Anticipation must be shown by clear and convincing evidence.
2. If one prior art reference completely embodies the same process or product as any claim, the product or process of that claim is anticipated by the prior art, and that claim is invalid. To decide whether anticipation exists, one must consider each of the elements recited in the claim and determine whether all of them are found in the particular item alleged to be anticipating prior art.
3. There is no anticipation unless every one of those elements is found in a *single* prior publication, prior public use, prior invention, prior patent, prior knowledge or

prior sale. One may not combine two or more items of prior art to make out an anticipation. One should, however, take into consideration, not only what is expressly disclosed or embodied in the particular item of prior art, but also what inherently occurred in its practice.

4. There cannot be an accidental or unrecognized anticipation. A prior duplication of the claimed invention that was accidental, or unrecognized, unappreciated, and incidental to some other purpose is not an invalidating anticipation.

Those four requirements must be kept in mind and applied to each kind of anticipation in issue. The following additional requirements apply to some categories of anticipation.

1. Prior Knowledge: An invention is anticipated if it was known by others in the United States before it was invented by the patentee. "Known," in this context, means known to the public. Private knowledge, secret knowledge or knowledge confined to a small, limited group is not necessarily an invalidating anticipation. Things that were known to the public only outside the United States are not invalidating anticipation.

2. Prior Use: An invention is anticipated if it was used by others before it was invented by the patentee, or more than one year before the patentee filed his patent application. "Use," in this context, means a public use.

3. Prior Publication: A patent is invalid if the invention defined by the claims was described in a printed publication before it was invented by the patentee or more than one year prior to the filing date of his application. For a publication to constitute an anticipation of an invention, it must be capable, when taken in conjunction with the knowledge of people of ordinary skill in the art, of placing the invention in the possession of the reader. The disclosure must be enabling and meaningful. In determining whether the disclosure is complete, enabling, and meaningful, one should take into account what would have been within the knowledge of a person of ordinary skill in the art at the time, and one may consider other publications that shed light on the knowledge such a person would have had.

4. Prior Patent: If the invention defined by the claims was patented in the United States or a foreign country, either before it was invented by the inventor or more than one year before the inventor filed his patent application, then the invention was anticipated. The effective date for this type of anticipation is the date on which two things co-existed: (i) the owner of the referenced patent had the right to enforce that patent; and (ii) the reference patent was available to the public. What was "patented" in the reference patent is determined by what is defined by its claims, interpreted in the light of the general description.

5. On Sale: A patent is invalid if the invention claimed in it was on sale in the United States more than one year prior to the application filing date.

6. Prior Invention: If the invention defined by the claims was invented by another person, in the United States, before it was invented by the inventor, and that other person did not abandon, suppress, or conceal the invention, the invention lacks novelty. A prior invention, even if put in physical form and shown to produce the desired result, is not an invalidating anticipation unless some steps were taken to make it public. However, it is not necessary that the inventor had knowledge of that prior invention.

7. Prior U.S. Application: A patent is invalid for lack of novelty if the invention defined by the claims was described in a United States patent issued on a patent application filed by another person before the invention was made by the inventor. The effective date of a prior application for purposes of this issue is the date on which it was filed in the United States. Foreign-filed patent applications do not apply. If the issued United States patent claims the benefit of more than one United States application, its effective date as an anticipation is the filing date of the first United States application that discloses the invention claimed in that referenced patent.

Experimental Use Exception: The law recognizes that it is beneficial to permit the inventor the time and opportunity to develop his invention. As such there is an "experimental use" exception to the "public use" and "on sale" rules. Even though the invention was publicly used or on sale, more than one year prior to the application filing date, that does not invalidate the patent, provided the principal purpose was experimenta-

tion rather than commercial benefit. If the primary purpose was experimental, it does not matter that the public used the invention or that the inventor incidentally derived profit from it.

When a public use or sale is shown, the burden is on the inventor to come forward with evidence to support the experimental use exception. Only experimentation by or under the control of the inventor qualifies for this exception. Experimentation by a third party, for its own purposes, does not qualify for this exception. Once the invention leaves the inventor's control, its use is a public one, even if further experimentation takes place.

The experimentation must relate to the claimed features of the invention. And it must be for the purpose of technological improvement, not commercial exploitation. If any commercial exploitation does occur, it must be merely incidental to the primary purpose of experimentation. A test done primarily for marketing, and only incidentally for technological improvement, is a public use.

CONCLUSION:

In view of the foregoing remarks, this application is considered to be in condition for allowance, and early reconsideration and a Notice of Allowance are earnestly solicited.

The undersigned hereby authorizes the Director to charge any fees that may be required, or credit any overpayments, to **Deposit Account No. 500777**. If an extension of time is necessary for allowing this Response to be timely filed, this document is to be construed as also constituting a Petition for Extension of Time Under 37 C.F.R. § 1.136(a) to the extent necessary. Any fee required for such Petition for Extension of Time should be charged to **Deposit Account No. 500777**.

Please link this application to Customer No. 53184 so that its status may be checked via the PAIR System.

Respectfully submitted,

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